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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,955	08/27/2003	Bennett M. Richard	D5407-188	4065

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EXAMINER

COLLINS, GIOVANNA M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

10/648,955

Applicant(s)

RICHARD ET AL.

Examiner

Giovanna M. Collins

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040315, 20030827.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because the figures are not clearly drawn. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,4,6, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Maguire et al.(US 2003/00447322).

Maguire discloses (see Fig. 5) a method of positioning a tubular in a borehole, comprising delivering the tubular (200) into the borehole; positioning the tubular in the borehole in a manner that leaves an annular space around it; and expanding the tubular (at 116).

Referring to claim 2, Maguire discloses providing a plurality of openings (at 220) in said tubular; disposing an extendable member (220) in each said opening.

Referring to claim 4, Maguire disclose a closed end on the extendable member (220) that is driven towards the borehole wall.

Referring to claim 6, Maguire discloses driving at least one of said extendable members (220) toward the borehole wall with said expansion.

Referring o claim 9, Maguire discloses penetrating the borehole wall with at least one of said extendable members (220).

4. Claims 1,14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Worrall et al. (5,348,095)

Worrall discloses (see Fig. 7)) a method of positioning a tubular in a borehole, comprising delivering the tubular (20) into the borehole; positioning the tubular in the borehole in a manner that leaves an annular space around it; and expanding the tubular (at 22).



Referring to claims 14 and 15, Worrall discloses expanding the tubular with a swage (22) or internal pressure (see figs. 5-6, at 7).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-13, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. (5,228,518) in view of Baugh (6,564,271).

Wilson discloses (see Fig. 2) a method of positioning a tubular in a borehole, comprising delivering the tubular (60) into the borehole; positioning the tubular in the borehole in a manner that leaves an annular space around it. Wilson does not disclose expanding the tubular. Baugh teaches expanding a tubular to connect it to a previously installed tubular (col. 2, lines 22-24)). As it would be advantageous to connect the tubular to a tubular already in the well, it would be obvious at the time of the invention to modify the method disclosed by Wilson to expand the tubular as taught by Baugh.

Referring to claim 2, Wilson discloses providing a plurality of openings (at 50) in said tubular; disposing an extendable member (50) in each said opening.

Referring to claim 3, Wilson discloses (see Fig. 3) keeping the extendable members substantially within the tubular.



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Referring to claim 4, Wilson discloses (see fig. 12) providing a closed end where the closed end is selectively driven toward the borehole wall.

Referring to claim 5, Wilson discloses (see fig. 5) providing a open end where the open end is selectively driven toward the borehole wall.

Referring to claim 7, Wilson, as modified, does not disclose driving the extendable members before expansion. Wilson does disclose the extendable members are use to centralize the tubular (col. 1, lines 7-10). As it would be advantageous to centralize the pipe in the correct position prior to expansion, it would be obvious to one of ordinary skill in the art at the time of the invention to further modify Wilson to have the extendable members driven before expansion.

Referring to claim 8, Wilson discloses locking the members against collapse (see Fig. 4, at 132, 142 and 141).

Referring to claims 9-10, Wilson discloses (see fig. 10) providing a open leading end on the extendable member that penetrates the borehole wall.

Referring to claims 11-12 and 20, Wilson discloses using internal pressure (col. 12, lines 68- col. 13 line 6) or mechanical force for driving.

Referring to claim 13, Wilson, as modified does not disclose the extendable member extends no further than an upset or coupling at a joint on the tubular prior to extending. However, Wilson discloses the extendable member can be a variety of shapes (col. 5, lines 13). Furthermore, a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Therefore it would be obvious to one of ordinary skill in the art to modify the method disclosed by Wilson to extend the extendable



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member no further than an upset or joint because size of a prior art device is a design consideration within the skill of the art.

Referring to claim 18, Baugh teaches delivering a sealing material under pressure through a tubular to an annular space and expanding the tubular before the sealing material sets up (col. 2, lines 27-35).

Referring to claim 19, Wilson discloses (see fig. 13) providing an open end and a closed end on at least one of the extendable members.

#### ***Allowable Subject Matter***

Claims 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 703-306-5707. The examiner can normally be reached on 6:30-3 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
gmc

  
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